

## REMARKS

Remarks to follow are numbered to correspond to the office action.

- 5 1. Claims 1-104 are still pending in this application, as now  
amended above and described below.

## Drawings

2. Replacement sheets for Figures 5-8, which are more-legible  
10 than the ones initially filed, are appended to the end of this  
reply. Applicant respectfully requests acceptance and entry of  
these new drawings, to replace the drawings for Figures 5-8 which  
were originally filed.

15 *Claim Objections*

3. The cited informalities are corrected herein. The [claim  
NN] brackets, which are an artifact from the old ABX electronic  
filing system, have been uniformly-removed from all claims  
without specifying this removal as a "current amendment." The  
20 informalities existing in eight (8) claims whereby an erroneous  
period is replaced by a comma have been so denoted as a "current  
amendment."

**Claim Rejections - 35 USC § 102**

- 25 4. Examiner rejects claims 1, 7, 8, 11-18, 21-23, 25, 30, 31,  
33-38, 43-51, 57, 58, 61-68, 71-73, 75, 80-81, 83-88, and 93-104  
as being anticipated by Bates.

Before examining these specific claims rejections, a number of comments are in order with respect to Bates.

The object of Bates, as is clearly set forth, for example, in column 1, line 14, is "to avoid repetitive use of key words

and phrases." As is later stated at column 1, lines 62-67:

"There is a need in the art for an improved technique for allowing users to determine and select alternate words and phrases when editing or creating a document to improve composition so that a reader of ordinary memory has had enough time to forget a key term or phrase before reading it again." As also stated in column 2, lines 44-48, "with the preferred embodiments, the user can view the repeated terms and determine how to substitute terms for the repeated terms **to avoid using the same term frequently**, which is undesirable from a composition standpoint." The whole purpose of Bates, as is clear throughout, is to identify where words or phrases are repeated in a literary document, and give the user an opportunity to avoid repetition by substituting alternative terms, phrases, roots, etc., with similar meaning, thereby enhancing the literary value of the resulting document.

While this is an important motivation for literary documents, for other types of documents such as business and legal forms and even patent documents, this literary objective of avoiding repetition is completely reversed by 180 degrees, and repetition, and consistency in terminology, is a paramount value.

For example, in patent disclosures and claims, it is important that repetition be ensured, so that matter presented in

a disclosure is consistently mapped with its recitation in claims. It is also important to ensure antecedent basis, that recitations in claims be tightly tied together and referenced so that there is no ambiguity about what the elements which a claim is intended to include. For example, using the word examples from Bates, if one patent claim were to refer to "a handicap," and a later claim to "said hardship," the reader would be hard-pressed to know for sure if those two statements referred to the same claim element, or to a different claim element. In this context, repetition of terminology not only desirable: it is required. Consequently, an invention such as Bates' which detects repetition so that the author can avoid and eliminate repetition, if used to help draft a patent application or a set of claims, would be counterproductive, doing *exactly the opposite* of what is desired and required and undermining the integrity of the document.

In short, Bates teaches precisely away from the types of substitutions that would be motivated for drafting a patent application, because for a patent document, one would want a computer program to detect seemingly-synonymous words and phrases, and give the user the opportunity to make them all the same, i.e., to repeat the reference throughout the patent document with the same terminology throughout. Such a program would see "handicap" in one place and "hardship" in another, note that they are synonyms, and give the user the opportunity to change one to the other *so that they are repeated*. In short, such a "patent-helper" program would perform a function exactly

the opposite of that performed by Bates. Bates removes repetition; here one would be ensuring proper repetitions. The literary objective of avoiding repetition is not at all in play, and in fact, the values required for a patent application  
5 are exactly the opposite.

So too for various business forms. It would serve no literary value to refer to a person's name on a business or legal form as "John" in one place, as "Jonathan" somewhere else, as "Johnny" yet elsewhere, and then as "Jack" in yet another place.  
10 The variation of language, which is the paramount literary value of Bates, is precisely opposite to the prevailing value of uniformity that is desired in business and legal forms, just as in the preceding example of patent applications.

Applicant's invention takes a document such as a legal  
15 contract, and, to ensure privacy as well as to develop generic forms out of specific documents, uses various methods to identify specific-case terms, and then offer the user opportunities to turn those into generic-case terms for privacy, or into suitable form "blanks" for generic utility to cases beyond the specific  
20 case for which they were first developed. Avoiding repetition is not only irrelevant in this context, it is counterproductive.

In this way, the motivation underlying Bates is precisely opposite to the motivation for applicant's invention. Bates' objective is the find words which are repeated, and allow the  
25 user to eliminate the repetition by substituting a synonymous term, phrase, root word, etc. Applicants' invention is to maintain repetition, and ensure that any substitutions which are

made, carry forward whatever repetitions subsist in the original document.

This leads to a very critical functional difference between Bates' patent, and applicant's claims as amended herein. Because the sole, paramount objective of Bates is to eliminate repetition, the one and only method by which Bates identifies terms and phrases and roots, etc., for which substitutes are to be proposed, is by searching a specified portion of a document to find repeated phrases. In fact, the most "repeated" statement throughout Bates, is the statement that "a determination is made of terms repeated in a section of text." (Abstract) Thus, for example, at column 2, lines 7-8: "A determination is made of terms repeated in a section of text." At column 2, lines 41-44: "Preferred embodiments provide a tool for use with a word processing program that locates repeated terms and provides the user with a list of possible substitute terms to use for the repeated term." At column 3, lines 36-37: "The composition program 14 searches specified portions of the document 16 for instances of repeated terms." At column 5, lines 22-25: "In response to being invoked, the composition program 14 parses (at block 102) the selected text and determines terms repeated within a predetermined section of text."

In fact, if one reads through the entirety of Bates, it is clear that terms, phrases, roots, etc., for which substitutions are to be offered, are uniformly "identified based upon a determination of which terms are repeated." There is not a single disclosure or suggestion that these terms might be

determined in any other way. Because the goal of Bates is to *help the author avoid repeated terms*, nor is there any motivation to identify these terms for which substitutions are to be offered in any other way. Detecting repetition of terms, within whatever  
5 portion of a document is selected by a user for this determination, is slavishly employed throughout Bates to determine the terms for which substitutions are to be offered.

In applicant's disclosure, "proposed substitutions" are offered for what applicant has dubbed as "specific-case terms,"  
10 and examiner appears to be reading applicant's verbiage "specific-case terms" on the "repeated terms" referenced throughout Bates. Presumably, this is because "substitutes" are then offered to the user for "repeated terms" in Bates, and for "specific-case terms" in applicant's invention. But, that is  
15 where the similarity ends, because while applicant discloses a number of different techniques to identify "specific-case terms," these techniques do NOT include finding repeated words.

In particular there are two key questions which arise from both Bates and from applicant's invention: a) how is it  
20 *determined* which terms, phrases, etc. are to be identified to the user for possible substitution?; and b) from whence, and how, does the user *select* the substitutions to be implemented? In short: *determination of where substitutions might be made*, and *selection of the actual substitutions to be made*. Examiner, in  
25 his rejections, has very much confused these two questions, because the answers for Bates, versus applicant, are completely different.

With this backdrop, we now turn to examine applicant's specific claims. In the discussion to follow, we will attempt where possible to review the rejections in the same order as examiner with the same groupings of claims, though in some situations, it will be preferred to employ a somewhat different order, or somewhat different groupings.

Claims 1, 51 and 101: All of these claims (as well as all other independent claims as discussed later in these remarks) are amended to specify that "said specific-case terms are **not** identified based upon a determination of which terms are repeated within said at least one source document." This clearly overcomes the 35 USC § 102 rejection based on Bates, because in Bates, "a determination of which terms are repeated" is the sole and exclusive means disclosed or suggested for identifying the terms, phrases, roots, etc., for which substitutions will be offered. Nor is there any motivation in Bates to employ any other means for identifying such terms, phrases, roots, etc., because the whole purpose of Bates is to help the author avoid repetitions which detract from literary value for a work where such literary value is indeed a value, and not an impediment to clarity (as with, e.g., a business or legal form or patent application).

Several of applicant's dependent claims do specify bases upon which to "identify specific-case terms." These include "sensitive identifying terms" (claims 3 and 53); "names in a name database" (claims 7 and 57); "patterns in a pattern grammar database" (claims 9 and 59); "identifying a particular section of

said at least one source document as being a section customarily containing specific-case terms" (claims 11 and 61); "terms in a collocation database" (claims 12 and 62); "terms in a rare word database" (claims 16 and 66); "types of specific-case terms" (claims 19 and 69); and "specific-case terms [identified] in [a] batch plurality of source documents" (claims 32 and 82). None of these bases includes the "repeated terms" basis upon which Bates rests in its entirety.

We shall separately discuss the additional points of patentable distinction arising out of the dependent claims just mentioned, and other dependent claims, in the discussion to follow. However, claims 1, 51 and 101, and all other independent claims, were rejected solely under 35 USC § 102 as being anticipated by Bates. Therefore, in light of the foregoing amendment to all of the independent claims that "specific-case terms are **not** identified based upon a determination of which terms are repeated," all rejections of record are overcome, and all of the independent claims should now be allowed. Therefore, all dependent claims are also now allowable, and applicant hereby respectfully requests allowance thereof.

The remainder of this reply outlines the various reasons for allowance in further detail.

Claims 7 and 57: Bates uses the name databases (e.g., Shakespeare, Biblical, Old English, American Slang, Mark Twain, etc.) for establishing association groups of substitute terms, not, as examiner incorrectly states, for "identifying a term as a specific case term based on said term matching a name in said



name database." In fact, as discussed at length above, Bates identifies a term for possible substitution of a different term *based solely on a word being repeated*. Nowhere does Bates disclose, suggest or motivate "identifying a term as a specific-  
5 case term based on said term matching a name in said name database" as recited in claims 7 and 57. Bates slavishly identifies such "specific case terms" (in Bates these are repetitively referred to throughout as "repeated terms") based solely on a determination of *repetition*.

10 The key point in this and several of the other comments to follow, is that the subject database in Bates is *not* used to *identify* the terms for which a substitution is to be offered. Rather, the subject database is used in Bates to offer the *substitutions themselves - after a term has been identified -*  
15 *because of its repetition - for which a substitution is to be offered*. This is a very important distinction. In applicant's disclosure, and as claimed, this database is used in the first instance, to identify the "specific case terms" for which substitutions are then to be offered. It is *not* used as a  
20 database of substitute terms, phrases, roots, etc., as in Bates. Claims 8 and 58: These claims depend on claims 7 and 57. Consequently, applicant's use of the name database is totally different than Bates' use thereof. Applicant uses such database to identify "specific case" terms for which substitutes are to be  
25 offered. Bates uses such database totally differently, as the source of the substitutions themselves. The rejection of these two claims rest on examiner's erroneous rejection of claims 7 and

57, in which this important difference is not correctly understood.

Claims 11 and 61: Again, Bates identifies a term for possible substitution of a different term *based solely on word or word root or phrase repetition*. Bates does not in any way disclose, suggest or motivate "identifying a term as a specific-case term based on said term being *located in the identified particular section* at a place customarily occupied by specific-case terms" as recited in these claims. Rather, Bates simply allows the user to search for repetitions, in a specified subsection of a document. A term is identified in Bates for possible substitution *only because it is repeated*. The specification by the user of a specific section *only specifies the section in which to search for repetitions*. A term or root or phrase being in the selected section is in and of itself *not* a criteria for proposing substitutions thereto; the sole basis is its repetition within that selected section.

Claims 12 and 62: As with claims 7 and 57, the subject database in Bates is *not* used to identify the terms for which a substitution is to be offered. Rather, the subject "collocation database" (which examiner extrapolates from the phrase "terms that Shakespeare uses together") is used in Bates *to offer the substitutions themselves - after a term has been identified for which a substitution is to be offered*. This is a very important distinction, and it is the same distinction already referred to several times previously. In applicant's disclosure, and as claimed, this "collocation database" is used in the first

instance, to identify the "specific case terms" for which substitutions are then to be offered. Examiner has completely missed this important distinction throughout the present office action. Not to sound "repetitive," (pun intended) but Bates  
5 slavishly identifies such "repeated terms" for which substitutions out of a database are to be offered, based solely on a determination of *repetition*. The database is then used as the source of substitutions for a repeated term, phrase, root, etc. With applicant's invention, the database is what identifies  
10 the specific-case terms for which substitutions are to be offered, *not* the repetition.

Claims 13, 14, 15, 63, 64 and 65: These claims depend on claims 12 and 62. Whether the collocation database is derived "from a corpus of a large number of documents of similar nature" (claims  
15 13 and 63), whether the collocation usage is below a "predetermined usage threshold" (claims 14 and 64), as well as the question of how one establishes "said predetermined usage threshold," are completely irrelevant. Applicant uses the collocation database to identify "specific case" terms for which  
20 substitutes are to be offered. Bates uses such database totally differently, as the source of the substitutions themselves. The rejection of these two claims rest on examiner's erroneous rejection of claims 12 and 62, in which this important difference is, once again, not correctly understood.

25 Claims 16, 17, 18, 66, 67 and 68: The rejection of claims 16 and 66, as well as their dependent claims 17, 18, 67, and 68, suffer the same defect as many of the previous dependent claim

rejections. Examiner apparently reads a "rare word" database into Bates, from the, e.g., Biblical and Shakespeare groups mentioned therein. If, for sake of argument, one takes these to be "rare word" databases, the question again is not whether they exist as elements *somewhere* in Bates and *somewhere* in applicant's invention, but *how they are employed in each*. Bates uses *only repetition* to determine the terms, phrases, roots, etc., for which substitutions are to be offered, and then uses these databases to provide the substitutions. Applicant, again, uses these databases to identify "specific case" terms for which substitutes are to be offered. The rejection of these claims continues to rest on this important difference which examiner has not properly understood.

Claims 21 and 71: These claims are dependent on allowable claims 1 and 51, and so now should be allowed on that basis.

Additionally, however, it is important to be clear about the process of word substitution, both in Bates and in applicant's invention. Applicant identifies a "specific case" term for which substitutes are to be offered based on a range of criteria - some of which have already been discussed - which have nothing to do with word repetition. Bates identifies terms, phrase, roots, etc. candidates for substitutions are to be offered, *based solely and slavishly on word repetition*.

Once a word is identified as one for which a substitution is to be offered, then there are two further steps. The first step is to provide a list of words, and to have the user select, from that list, which words are to be substituted. The second step,

is to give the user the opportunity to *undo* a word substitution after it has already been selected, i.e., allowing the user to change his or her mind. What is described in column 4, lines 27-31 of Bates, entails removing a term from an "association group,"

that is, removing a term from the list of word substitutions which are being offered, so that the removed word will not be offered in the future. To make clear that applicant's "undo" function is not interpreted to read on this, applicant's claims 21 and 71, as amended, now recite "undoing a proposed

substitution *previously selected by a user*," which does not in any way read on Bates' removing a term "from the group of words associated with the term in the 'association with' box" as disclosed at column 4, lines 29-30. This give further patentable weight to claims 21 and 71.

Claims 31 and 81: Examiner rejected claims 31 and 103 together, and apparently overlooked claim 81 entirely, since the office action, apparently erroneously, contains no specific discussion of the reasons for the claim 81 rejection. Applicant will later discuss claim 103 separately since that is an independent claim.

At this time, applicant will assume that examiner meant to reject dependent claim 81 for the same reasons as dependent claim 31, and so will consider these two claims together here as if this was in fact the case.

These claims are allowable based at least on their dependence upon allowable claims 1 and 51. In addition, these claims are herein amended to make clear that the recited "juxtaposition" entails "sections of said at least one source

document containing said specific-case terms, juxtaposed relative to *sections* of said at least one source document containing said general-case terms, to facilitate comparison between said *sections*." This does not in any way read on Figure 3 (or any other figure or disclosure) of Bates wherein only one document section - not two - is displayed. Applicant's juxtaposition as illustrated in Figure 6 provides decidedly more complete information to the user with this juxtaposed display of both the original section and the section with the proposed substitutions. This claims amendment has clear support in applicant's Figure 6, which applicant's paragraph [0021] states is "a side-by-side (juxtaposed) view of all substitutions of a selected single term, that is, *showing the paragraphs which include substitutions of the selected term, side-by-side with the original source document*."

Claims 22, 23, 25, 30, 72, 73, 75, and 80: These claims are the remaining claims rejected under 35 USC § 102 as being anticipated by Bates, which are also dependent upon allowable independent claims 1 and 51, as already discussed. All of these dependent claims are also therefore allowable, based at least upon this dependence on allowable claims 1 and 51.

Claims 33, 83 and 102: All three of these claims are *independent*. As with earlier-discussed claims 1 and 51, these claims are also amended to specify that "said specific-case terms are *not* identified based upon a determination of which terms are repeated within said at least one source document." For the same reasons discussed earlier in reference to independent claims 1

and 51, this overcomes the 35 USC § 102 rejection based on Bates, because Bates identifies terms, phrases, roots, etc. for which substitutions will be offered, *exclusively and solely based on which terms are repeated*, within whatever section of the document the user selects.

As such, the 35 USC § 102 rejection of these claims based on Bates is overcome, and because there is no further rejection of record for any of these claims, these claims are now allowable. Additionally, all claims which depend upon claims 33 and 83 (claim 102 has no dependents) are also allowable based at least on this dependency. Consequently, applicant hereby respectfully requests allowance of claims 33, 83 and 102 and all of their dependents.

From here, we turn to a further discussion of the claims which are dependent upon claims 33 and 83, and further points of patentable distinctness.

Claims 34 and 84: These two claims, which depend respectively on claims 33 and 83, are amended to recite "displaying for a particular general-case term and its related specific-case term, a *numeric tally* of how many times said particular general-case term is proposed to be substituted for said related specific-case term," thus providing additional patentable distinctness.

Examiner states that in Bates' Figure 2 and 3, "52b shows the number of times general case of handicaps and satisfaction is proposed to be substituted for specific case terms . . ." To be precise, the user would be able from 52b to engage in a visual examination to count up, in his or her head, how many times a

substitution is proposed to be made. As amended, claims 34 and 84 now recite the display of "a numeric tally," which can not in any way be interpreted to read on the information that the user is forced to deduce for him or her self from Bates' 52b.

Support for this recitation of "a numeric tally," and for how this phrase is to be understood in the context of applicant's disclosure as a visual "number" which the user sees on a display and which thereby saves the mental counting up of substitutions, can be found, for example, in applicant's paragraph [0108] which states ". . . in a display such as that of FIG. 5, it is possible to generate a proper substitution list *including the number of occurrences* of each proposed substitution. . . ." This is further amplified in paragraph [0111] which states, referring still to FIG. 5, that "the bottom screen contains a substitution list showing the **tally** of the substituted words--for example, AKA1 replaced Morfax **66 times throughout the document**." Finally, the illustration of Figure 5 does indeed display this "numeric tally" by the appearance of the illustrative number "66," just as discussed in the disclosure. Bates provides no disclosure or suggestion of such a "numeric tally" along the lines of that displayed in applicant's FIG. 5. As such, the recitation of such a "numeric tally" adds further patentable distinctness to dependent claims 34 and 84, by reading clearly around Bates.

Claim 35 and 85: These two claims, which also depend respectively on claims 33 and 83, are herein amended to recite "undoing a proposed substitution *previously selected by a user*, by designating a proposed substitution to be undone, using a



computerized input device." The earlier discussion regarding claims 21 and 71 applies equally to claims 35 and 85, and lend further patentable weight to these claims.

Claims 36, 37, 38, 86, 87 and 88: These claims are the remaining

claims rejected under 35 USC § 102 as being anticipated by Bates, which are also dependent upon allowable independent claims 33 and 83, as already discussed. All of these dependent claims are also therefore allowable, based at least upon this dependence on allowable claims 33 and 83.

Claims 43, 93 and 103: All three of these claims are independent. As with earlier-discussed claims 1 and 51, these claims are also amended to specify that "said specific-case terms are not identified based upon a determination of which terms are repeated within said at least one source document." For the same reasons discussed earlier in reference to independent claims 1 and 51, this overcomes the 35 USC § 102 rejection based on Bates, because Bates identifies terms, phrases, roots, etc., for which substitutions will be offered, exclusively and solely based on which terms are repeated, within whatever section of the document the user selects.

As such, the 35 USC § 102 rejection of these claims based on Bates is overcome, and because there is no further rejection of record for any of these claims, these claims are now allowable. Additionally, all claims which depend upon claims 43 and 93 (claim 103 has no dependents) are also allowable based at least on this dependency. Consequently, applicant hereby respectfully requests allowance of claims 43, 93 and 103 and all of their

dependents. From here, we turn to a further discussion of the claims which are dependent upon claims 43 and 93, and some of their additional points of patentable distinctness.

Claims 44 and 94: These claims depend respectively on

independent claims 43 and 93, and so are allowable on that basis alone. Further, similarly to the earlier-discussed amendments of claims 31 and 81, these claims are hereby amended to recite "displaying a subset of said at least one source document and a corresponding subset of said proposed substitution document, showing sections of said at least one source document containing proposed substitutions of general-case terms, juxtaposed relative to sections of said at least one source document containing said specific-case terms, to facilitate comparison between said sections."

As with claims 31 and 81, this does not in any way read on Figure 3 (or any other disclosure) of Bates wherein only one document section - not two - is displayed. Applicant's juxtaposition as illustrated in Figure 6, again provides decidedly more complete information to the user with the juxtaposed display of both the original section and the section with the proposed substitutions. As in the earlier discussion for claims 31 and 81, this amendment has clear support in applicant's Figure 6, which applicant's paragraph [0021] states is "a side-by-side (juxtaposed) view of all substitutions of a selected single term, that is, *showing the paragraphs which include substitutions of the selected term, side-by-side with the original source document.*"

Claims 45, 95 and 104: All three of these claims is *independent*, and these are the last of the dependent claims pending in this application remaining to be discussed in depth. As with earlier-discussed claims 1 and 51, these claims are also amended to  
5 specify that "said specific-case terms are not identified based upon a determination of which terms are repeated within said at least one source document." For the same reasons discussed earlier in reference to independent claims 1 and 51, this overcomes the 35 USC § 102 rejection based on Bates, because  
10 Bates identifies terms, phrases, roots, etc., for which substitutions will be offered, based exclusively and solely on which terms are repeated, within whatever section of the document the user selects.

As such, the 35 USC § 102 rejection of these claims based on  
15 Bates is overcome, and because there is no further rejection of record for any of these claims, these claims are now allowable. Additionally, all claims which depend upon claims 45 and 95 (claim 104 has no dependents) are also allowable based at least on this dependency. Consequently, applicant hereby respectfully  
20 requests allowance of claims 45, 95 and 104 and all of their dependents.

Based on all of the foregoing, all pending claims in this application should now be allowed, and applicant hereby respectfully requests a notice of allowance in the near future.

25 From here, we turn to a further discussion of the claims which are dependent upon claims 45 and 95, and some of their additional points of patentable distinctness.

Claims 47 and 97: These claims are allowable based on their dependence on allowable independent claims 45 and 95. In addition, similarly to claims 34 and 84 as discussed earlier, these claims are now amended to recite displaying "a numeric tally of how many times said particular general-case term is proposed to be substituted for said related specific-case term." This provides additional points of patentable distinctness, for the same reasons earlier discussed in relation to claims 34 and 84.

Claims 48 and 98: These claims depend from allowable independent claims 45 and 95, and so are allowable at least on that basis. Additionally, similarly to claims 21 and 71, and 35 and 85 as earlier discussed, these claims are herein amended to recite "undoing a proposed substitution previously selected by a user," and so add patentable distinctness for the same reasons outlined in the earlier discussions of claims 21 and 71, and 35 and 85.

Claims 46, 49, 50, 96, 99 and 100: These claims are the remaining claims rejected under 35 USC § 102 as being anticipated by Bates, which are also dependent upon allowable independent claims 45 and 95, as already discussed. All of these dependent claims are also therefore allowable, based at least upon this dependence on allowable claims 45 and 95.

Applicant would like to register, for the record, his disagreement with examiner's statement with reference to claims 46 and 96, that "multiple sentences make a paragraph, which can be seen as a batch plurality of source documents." This stretches the common understanding in the computer arts of "batch

processing" beyond all reasonable recognition.

***Claim Rejections - 35 USC §103***

5. Examiner rejects claims 2-6, 9-10, 19-20, 26-29, 32, 39-42,  
5 52-56, 59-60, 69, 70, 76-79, 82, and 89-92 under 35 USC § 103, as  
being unpatentable based on Bates as above, in view of Grober.  
Though not stated clearly, it appears that claims 24 and 74 are  
being rejected on the basis of these two patent documents,  
further combined with a third document, namely the Walfish  
10 patent.

Because independent claims have been rejected solely under  
35 USC § 102, and because these rejections have now been overcome  
as a result of the foregoing amendments and discussion, these  
claims and their dependents are now all allowable, and all  
15 remaining rejections are moot and need not be discussed any  
further here. Additionally, no further claims amendments are  
required to secure a notice of allowance based on all prior-art  
rejections of record.

However, in the interest of expediting prosecution to  
20 allowance, applicant does which to discuss a few pertinent issues  
with regards to the 35 USC § 103 rejections.

Most importantly, there is no justification whatsoever for  
combining Bates with Grober under 35 USC § 103. Not only does  
each reference fail to in any way suggest such a combination, but  
25 Bates, in particular, *teaches directly away* from such a  
combination, because, as already discussed at length, the goal of  
Bates is to identify and eliminate repetition, while the goal of

applicant's invention is quite the opposite, namely, to preserve repetition, and ensure uniform, repetitive substitution of general-case terms for specific-case terms. If a specific-case term repeatedly appears, say, 66 times in a document as in applicant's paragraph [0111] and FIG. 5 example, then applicant's objective is to ensure that the same general-case term is uniformly-substituted 66 times throughout the document. There is no motivation for applicant's invention to propose substitutions to *reduce repetition* (in fact this would undermine the uniformity of terminology required by, e.g., legal and business documents, and even patent documents), just as there is no motivation in Bates to propose substitutions to maintain or increase repetition (because Bates' sole objective is to reduce repetition). Thus, as pointed out previously, the literary values of Bates are 180 degrees opposite to the literary values served by applicant's invention, and so *there is no conceivable motivation based on anything in Bates, to combine Bates with Grober in order to arrive at applicant's invention*. As a result, the 35 USC § 103 rejections are entirely moot and need not be discussed any further.

Notwithstanding the above, and although *none of the independent claims has been rejected under 35 USC § 103 using Bates together with Grober*, applicant has optionally chosen herewith, to further amend all of the independent claims, namely, 1, 33, 43, 45, 51, 83, 93, 95, 101, 102, 103 and 104, to recite that "said specific-case terms are so-identified *without making use of HTML elements preexisting* within said at least one source

document."

Grober, like Bates, and like applicant, does at times substitute one word or phrase for another. However, these substitutions take place in very different ways, on very different bases, and for very different purposes, all of which are patentably distinct.

In Bates, the words for which substitutions are to be proposed are identified by slavishly looking for repeated terms, phrases, roots, etc. In applicant's invention, the specific-case terms are identified by a variety of techniques such as those specified in, for example, dependent claims 7, 11, 12, 16, 57, 61, 62, 66, which do not make use of searching for repetition, but rely on a variety of database and similar techniques. In Grober, the root of any operation to be performed, is based on HTML tags *preexisting within the document*. There is, however, nothing anywhere in Grober which discloses or suggests how these HTML tags arrive in the document in the first place, other than what is effectively by hand coding, or by a vague reference to "recorder-based techniques," see paragraph [0029]. There is no indication anywhere in Grober of any sort of automated process, whether by detecting repetition, or otherwise, of how these tags are placed at the outset for driving the attributes of the GUI display. They are just "there." Without specifying in some degree of detail, some sort of methodology by which Grober searches through a document and, on some basis, decides in an automated fashion where to place the tags, *there is absolutely nothing in Grober which motivates a combination with Bates*.

For the most part, Grober is simply a forms engine, which drives the process of displaying certain messages in connection with certain form fields to be filled in, and which pre-fills certain of the form fields when it is suitable to do so (e.g., the example of the refinancing option which causes the address of the existing property to be filled in, and blocks the freedom of the user to fill this in manually.) Like any forms program, it is important, though entirely trivial, to ensure uniformity from one form window to the next, so, that, for example, the buyer name which appears in one form window then carries through automatically to later form windows. But this is all routine forms management, and it is a great stretch to read any of this on what applicant's invention is doing, notwithstanding the further defect in the examiner's rejections that there is no suggestion to combine references. Bates, if anything, teaches very directly away from such a combination, as has been made clear throughout these remarks.

For example, claims 2, 39, 52 and 89, as optionally amended herein (although these are already allowable even without amendment based on all of the foregoing), recite "for all identified occurrences of a particular specific-case term, uniformly substituting a *single* general-case term therefor." This clearly takes this out of any reach by Bates under 35 USC §102 or §103, because leaving repeated terms untouched, and moreover, *uniformly substituting a single term for all repeated terms* thereby *maintaining the original repetitions* albeit with a substitute repeated word or term, is complete heresy with respect



to the object of Bates to remove repetition from a literary document. This further removes any possible support for combining these references under 35 USC § 103.

Other issues raised by examiner, such as the blanking out of fields in relation to claims 3 and 53, or the consistent display of each form field throughout various form windows in relation to claims 5, 6, 28, 29, 41, 55, 56, 78, 79 and 91, are nothing more than simple, trivial, basic operations which must take place in any useful forms engine. But, it is a far stretch to combine these basic forms operations with Bates - which teaches away from applicant's invention for the reasons enumerated - and then to assert that this combination teaches applicant's invention as a whole. There is no suggestion that these references be combined, Bates teaches away from their combination, and even if they were to be combined, and even if impermissible hindsight were to be applied, it would still not be apparent for someone of ordinary skill in the art to arrive at applicant's claimed invention as a whole, especially because the motivations and objects among the Bates, Grober and applicant's inventions are so very disparate from one another.

Remaining Dependent Claims: The remaining dependent claim rejections are problematic as well, but need not be addressed here specifically, first, because all of the independent claims and so too all dependent claims are now allowable as previously discussed in relation to the 35 USC § 102 rejections under Bates; secondly, because there is no colorable motivation provided either by Bates, or by Grober, for someone of ordinary skill in

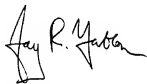
the art to combine Bates with Grober; and third, because even if these references were combined with impermissible hindsight, applicant's invention would still not be apparent to someone of ordinary skill due to such disparate motivations. Bates, especially, teaches in the completely opposite direction from such a combination, because its primary object is to reduce repetition of terms in a literary document while applicant's goes is to maintain repetition, and map this over into repetitive, uniform substitutions of general-case terms for specific case terms.

Other Amendments: Applicant has made several other miscellaneous amendments of applicant's own volition, not necessitated in any way by the office action. Primarily, these entail uniformly removing the "step(s) of" language from the method claims, and uniformly using the terminology "at least one source document" with respect to all appearances of "source document" as a claim element.

### ***Conclusion***

6. For the foregoing reasons, all rejections of record have now been overcome. Applicant looks forward to a notice of allowance in the near future. As noted earlier, if these amendments and remarks do not place this application into condition for allowance, applicants' counsel hereby respectfully requests a telephone interview with examiner Ann J. Chempakaseril, following receipt of this reply, and prior to issuance of any further office action.

Respectfully submitted,

A handwritten signature in black ink, reading "Jay R. Yablon". The signature is written in a cursive style with a large, stylized "J" and "Y".

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